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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,272	02/29/2000	David B. Kinder	ITL-0315US (P7998)	1987
21906 7590 04/17/2009 TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631				
EXAMINER				
SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
2424				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/15/272

Applicant(s)

KINDER ET AL.

Examiner

JAMES SHELEHEDA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9,12-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,12-16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 02/24/09 has been entered.

Response to Arguments

2. Applicant's arguments filed 02/24/09 have been fully considered but they are not persuasive.

On page 6, of applicant's response, applicant argues that none of the cited references disclose "posing a question in the course of actually watching the content to be sure that the user is actually viewing the content and not receiving an incentive just for leaving the TV on".

In response, it is noted that Candelore was relied upon to disclose this feature when it was previously claimed in dependent claims 10-11 and 17-18. Candelore explicitly discloses asking the user a question and requiring an answer to verify the user

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is actually watching (column 12, lines 47-56). Therefore, applicant's arguments are not convincing.

Furthermore, it is noted that the rejection of this feature under Candelore was previously sustained by the BPAI (see pages 10-11 of the board decision rendered 12/124/08).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 3, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (5,604,542) (of record) in view of Candelore (6,057,872) (of record).

Regarding Claim 1, Dedrick discloses a method comprising transmitting video content (Col. 2, Lines 25-28) and transmitting electronic advertisements (Col. 2, Lines 10-14) comprising graphics (Col. 2, Line 19) in the vertical blanking interval of the video signal (Col. 2, Lines 20-33). The advertisement may be a redeemable coupon (Col. 3, Lines 2-3). Information carried in the VBI signal must be encoded such that the advertisement image is split up into packets (Col. 2, Lines 35-64). The image is subsequently delivered to a receiver one bit at a time in a serial data stream. This reads on the claimed transmitting a viewer incentive image (electronic advertisement including

a redeemable coupon) over time in association with the video content (television program). In order to receive all the packets for a particular image, the user must be tuned to the channel carrying the data for a sufficient duration of time. This reads on the claimed incentive images accumulating depending on viewing time. What is not disclosed, however, is electronically posing a question in the course of transmitting the video content to determine whether the viewer is actually watching the content and only accruing the incentive when the viewer is actually watching the content.

Candelore discloses a system for transmitting digital coupons (Col. 4, Line 63 – Col. 5, Line 5) in order to reward viewer loyalty in a cable television network (Col. 5, Line 26) based on a viewer's consumption of programming (Col. 6, Lines 27-31) wherein the system verifies that the subscriber is present and viewing a program by asking the subscriber a question and requiring the subscriber to provide interactive input (Col. 3, Lines 53-62 and Col. 12, Lines 47-56). This reads on the claimed electronically posing a question in the course of transmitting the video content to determine whether the viewer is actually watching the content and only accruing the incentive when the viewer is actually watching the content. Candelore is evidence that one of ordinary skill in the art would appreciate the ability to ensure a viewer is actually paying attention to programming before providing a reward for watching the programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick in view of Candelore in order to prevent viewers from gaining rewards for content they didn't actually view.

Regarding Claim 2, Dedrick and Candelore disclose a method as stated above in Claim 1. Dedrick further discloses transmitting portions of a viewer incentive image (advertisement) in association with the content (television program) includes transmitting the viewer incentive image portions (packetized data) together with the television content in the program's VBI, as stated above.

Regarding Claim 3, Dedrick and Candelore disclose a method as stated above in Claim 1. Dedrick further discloses that transmitting video content includes transmitting video programming (television programming) together with ancillary information (VBI data, See Figures 3-5) and transmitting the viewer incentive image portions (advertisement/coupon) as part of the ancillary information (VBI data) as stated above. As is well known in the art, the VBI may contain closed captioning information as well as other embedded data.

Regarding Claim 6, Dedrick and Candelore disclose a method as stated above in Claim 1. What is not disclosed, however, is progressively providing incentives, which may be collected in a graphical user interface for display. Candelore further discloses a system for transmitting digital coupons (Col. 4, Line 63 – Col. 5, Line 5) in order to reward viewer loyalty in a cable television network (Col. 5, Line 26) based on a viewer's consumption of programming (Col. 6, Lines 27-31). Further disclosed is that incentives may be collected in a graphical user interface for display (See Figures 4-5 and Col. 10, Lines 19-45). Candelore is evidence that ordinary workers in the art would appreciate

the ability to display a viewer's collected coupons in a graphical user interface.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method of Dedrick and Candelore with the GUI in order to allow a user to manage and spend their accrued coupons immediately.

Regarding Claim 9, Dedrick and Candelore disclose a method as stated above in Claim 1. Dedrick further discloses including parsing enhanced content from the video content (decoding the VBI information) and parsing an incentive from the enhanced content (displaying or printing the advertisement, Col. 3, Lines 24-41).

5. Claims 12-15, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of the PNG Specification, Version 1.0 (of record) and Candelore.

Regarding Claim 12, Dedrick discloses an electronic system (See Figure 1) with an encoder (14), transmitter (80), receiver (82) and decoder (84). As is well known in the art, such digital computing devices comprise a medium for storing instructions that cause a processor to perform a function. This system performs the method of transmitting video content (Col. 2, Lines 25-28) and transmitting electronic advertisements (Col. 2, Lines 10-14) comprising graphics (Col. 2, Line 19) in the vertical blanking interval of the video signal (Col. 2, Lines 20-33). The advertisement may be a redeemable coupon (Col. 3, Lines 2-3). Information carried in the VBI signal must be encoded such that the advertisement image is split up into packets (Col. 2, Lines 35-64). The image is subsequently delivered to a receiver one bit at a time in a serial data stream. This reads on the claimed transmitting partial, incomplete portions (packets) of

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a complete viewer incentive image (electronic advertisement including a redeemable coupon) over time in association with the video content (television program). In order to receive all the packets for a particular image, the user must be tuned to the channel carrying the data for a sufficient duration of time. This reads on the claimed incentive images accumulating depending on viewing time to form the complete image. What is not disclosed, however, is enabling the partial incomplete portions to be displayed and viewed without displaying the complete incentive image, the extent of the image that is displayed being dependent on the time spent viewing the video content. and electronically posing a question in the course of transmitting the video content to determine whether the viewer is actually watching the content and only accruing the incentive when the viewer is actually watching the content.

In an analogous art, the PNG Specification discloses a bitmap image file format featuring serial streamability and progressive display (Chapter 1, Introduction). This allows the image file to be displayed as it is received over a communication link (Chapter 1, Introduction and Chapter 2.6, Interlaced data order). Such serial streaming and progressive display of image data reads on the claimed enabling the partial incomplete portions of the incentive image to be displayed and viewed without displaying the complete image. In combination with Dedrick, the image data is transported serially in a packetized VBI stream and is received based on the time spent viewing the video content. The PNG Specification is evidence that one of ordinary skill in the art would appreciate the ability to display a partial, incomplete image as it is received over time. Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to modify the method of Dedrick with the progressive display of the PNG Specification in order to "provide the user with a meaningful display much more rapidly."

Additionally, Candelore discloses a system for transmitting digital coupons (Col. 4, Line 63 – Col. 5, Line 5) in order to reward viewer loyalty in a cable television network (Col. 5, Line 26) based on a viewer's consumption of programming (Col. 6, Lines 27-31) wherein the system verifies that the subscriber is present and viewing a program by asking the subscriber a question and requiring the subscriber to provide interactive input (Col. 3, Lines 53-62 and Col. 12, Lines 47-56). This reads on the claimed electronically posing a question in the course of transmitting the video content to determine whether the viewer is actually watching the content and only accruing the incentive when the viewer is actually watching the content. Candelore is evidence that one of ordinary skill in the art would appreciate the ability to ensure a viewer is actually paying attention to programming before providing a reward for watching the programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick and PNG in view of Candelore in order to prevent viewers from gaining rewards for content they didn't actually view.

Regarding Claim 13, Dedrick in view of the PNG Specification disclose a method as stated above in Claim 1. Dedrick further discloses transmitting portions of a viewer incentive image (advertisement) in association with the content (television program)

includes transmitting the viewer incentive image portions (packetized data) together with the television content in the program's VBI, as stated above.

Regarding Claim 14, Dedrick in view of the PNG Specification disclose a method as stated above in Claim 1. Dedrick further discloses that transmitting video content includes transmitting video programming (television programming) together with ancillary information (VBI data, See Figures 3-5) and transmitting the viewer incentive image portions (advertisement/coupon) as part of the ancillary information (VBI data) as stated above. As is well known in the art, the VBI may contain closed captioning information as well as other embedded data.

Regarding Claim 15, Dedrick in view of the PNG Specification disclose an article as stated above in Claim 12. Dedrick further discloses storing instructions that cause a processor-based system such as encoder (14) and transmitter (80) to progressively provide, in the form of a serialized data stream encoded in the television show's VBI, an image portion of an overall incentive image (advertisement/coupon) which may be earned by those viewers who view programming for a given amount of time as stated above in Claim 1.

Regarding Claim 19, see Claim 12 above. Dedrick further discloses a video content receiver (82) and a data decoder (84). The decoder removes the electronic advertisement from the VBI and extracts the transmitted information (Col. 3, Lines 25-

28). The decoder therefore reads on the claimed ancillary content receiver. Further disclosed is a transmitter (80).

Regarding Claim 20, see Claim 13 above.

Regarding Claim 21, Dedrick in view of the PNG Specification and Candelore disclose a system as stated above in Claim 19. What is not disclosed, however, is that the video content and ancillary information are transmitted at separate times. Candelore further discloses a system as stated above, wherein the digital coupon information may be transmitted via a separate path from the television programming (Col. 5, Lines 53-55). This reads on the claimed video content and ancillary information being transmitted at separate times. Candelore is evidence that one of ordinary skill in the art would appreciate the ability to use a separate transmission path for video services and digital coupon information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the system of Dedrick in view of the PNG Specification and Candelore with the separate transmission path in order to implement a bi-directional network for interactive distribution and feedback or to provide a higher bandwidth transmission channel than VBI for the interactive advertisement information.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick and Candelore and further in view of Bauminger et al. (Bauminger) (6,681,393) (of record).

Regarding Claim 5, Dedrick and Candelore disclose a method as stated above in Claim 1. What is not disclosed, however, is showing the portion of an incentive image that has not yet been earned. Bauminger discloses an interactive television system for displaying advertisements (Co1. 5, Lines 21-34) and accumulating a history of users interactions (Col. 6, Lines 16-49) in order to provide a coupon or prize (Co1. 5, Lines 1-7). Bauminger further discloses displaying to the user a portion of an incentive image that has not yet been earned (See Figures 1A and 1B). Bauminger is evidence that ordinary workers in the art would recognize the benefits of prompting users with an unearned portion of an incentive, such as how many times the user is required to participate in a contest to receive a coupon (Col. 5, Lines 32-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick and Candelore with the display of an unearned portion of an incentive of Bauminger in order to increase viewer participation and consumption of advertising by encouraging the viewer to participate in more interactive advertising content as disclosed by Bauminger (Col. 5, Lines 32-39).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of the PNG Specification, Version 1 and Candelore and further in view of Bauminger et al. (Bauminger) (6,681,393) (of record).

Regarding Claim 16, Dedrick in view of the PNG Specification and Candelore disclose a method as stated above in Claim 1. What is not disclosed, however, is showing the portion of an incentive image that has not yet been earned. Bauminger

discloses an interactive television system for displaying advertisements (Co1. 5, Lines 21-34) and accumulating a history of users interactions (Col. 6, Lines 16-49) in order to provide a coupon or prize (Co1. 5, Lines 1-7). Bauminger further discloses displaying to the user a portion of an incentive image that has not yet been earned (See Figures 1A and 1B). Bauminger is evidence that ordinary workers in the art would recognize the benefits of prompting users with an unearned portion of an incentive, such as how many times the user is required to participate in a contest to receive a coupon (Col. 5, Lines 32-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick in view of the PNG Specification and Candelore with the display of an unearned portion of an incentive of Bauminger in order to increase viewer participation and consumption of advertising by encouraging the viewer to participate in more interactive advertising content as disclosed by Bauminger (Col. 5, Lines 32-39).

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick and Candelore and Robertson et al. (Robertson) (6,486,895) (of record).

Regarding Claims 7 and 8, Dedrick and Candelore disclose a method as stated above in Claim 1. Further, Dedrick in view of Candelore disclose a method as stated above in Claim 6 wherein incentives are provided in a graphical user interface. What is not disclosed, however, is a graphical user interface, which may be viewed in a virtual book of pages of incentives or enabling the pages to appear to be turned by operating the graphical user interface. Robertson discloses a graphical user interface system that

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utilizes a book metaphor (See Abstract and Figures 10-12) that enables a user to turn pages (Col. 2, Lines 38-47). Robertson is evidence that ordinary workers in the art would recognize the benefits of displaying electronic data in a book metaphor. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Dedrick and Candelore with the book metaphor of Robertson in order to allow users to easily access the stored coupon data in a visual way that is natural and easy for them to understand.

Conclusion

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____.
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Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/
Examiner, Art Unit 2424

JS